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Atty. Docket No. 017499/0161

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK TRIAL AND APPEAL BOARD**



In re Trademark Application of

SUNX LIMITED

06-10-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Serial No.: 75/530,534

Trademark Atty: LaVerne T. Thompson

Filed: August 4, 1998

Law Office: 116

Mark: S-LINK & DESIGN

**NOTICE OF APPEAL and REQUEST FOR SUSPENSION OF APPEAL**

BOX TTAB/ FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202

Sir/Madam:

Notice of Appeal

Applicant hereby appeals to the Trademark Trial and Appeal Board from the final refusal to register on the Principal Register issued on December 10, 2002 in the above-identified application.

A check in the amount of \$100.00 is attached to cover the appeal fee, for one Class of goods. If any additional fee should be required, please charge the same to Deposit

Account No. 19-0741.

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Request for Suspension of Appeal

Applicant respectfully requests that the Appeal in the above-identified application be suspended. Applicant requests suspension of the Appeal in order to allow the

Examining Attorney sufficient time to consider Applicant's Amendment and Request for Reconsideration, which is being filed concurrently herewith.

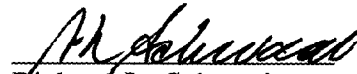
In summary, a final refusal was mailed on December 10, 2002. On May 26, 2003, Applicant spoke with the Examining Attorney, Ms. LaVerne Thompson, concerning possible amendments to the application and arguments to counter the refusal. On June 10, 2003, Applicant timely filed an Amendment and Request for Reconsideration. It is believed that the amendments and arguments presented will resolve the outstanding issue raised by the Examining Attorney and obviate the need for an Appeal.

To preserve the issues for Appeal, Applicant is filing the required Notice of Appeal. In addition, Applicant is filing this Request for Suspension of the Appeal in order to allow the Examining Attorney sufficient time to consider Applicant's Amendment and Response.

If there are any questions, please contact the undersigned at (202) 672-5300 in Washington, D.C.

Respectfully submitted,

Date: June 10, 2003

  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Trademark Application of

**SUNX LIMITED**

Serial No.: 75/530,534

Trademark Atty: LaVerne T. Thompson

Filed: August 4, 1998

Law Office: 116

Mark: **S-LINK & DESIGN**

Response/NO FEE

**AMENDMENT AND REQUEST FOR RECONSIDERATION**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202



06-10-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

Sir/Madam:

In response to the Final Office Action mailed on December 10, 2002, please amend the above-identified application as follows.

**AMENDMENT**

**Identification of Goods**

Please delete the current identification of goods in its entirety and insert the following therefor (changes underlined):

Electrical communication apparatus, namely input/output connectors for (PLC) programmable logic controllers, controllers for connection to open networks, control boards for actuator sensors, input/output arrayed terminals for actuator sensors, input/output modules, hook-up connectors, photoelectric sensors, proximity sensors, pressure sensors, fiber sensors, ultrasonic sensors; handy monitors with controller functions for use in testing power cables and telecommunications cables; electric, power, telecommunications and optical fiber cables; optical

communication apparatus, namely optical modulators, optical isolators, optical switches and optical circulators; excluding computer software for translation, transfer and sharing of data between digital audio and video processing workstations systems, in Class 9.

### **REMARKS**

Applicant's counsel wishes to thank the Examining Attorney, Ms. LaVerne T. Thompson, for her courtesy during a telephone conversation on May 28, 2003, at which time several proposed changes to the identification of goods were discussed. As a result of that conversation, Applicant has amended the application to more clearly specify the goods offered under its mark, and at the same time, make clear that its goods are unrelated to those in cited Registration No. 1,962,364, discussed further below.

Applicant has amended the identification of goods to specify and limit the field of use for its "programmable logic controllers", "input/output connectors," "control boards" and "input/output arrayed terminals". Also, Applicant has deleted the indefinite term "devices" and excluded use of the mark for "computer software for translation, transfer and sharing of data between digital audio and video processing workstations systems."

The Examiner assigned to this application has changed since Applicant's last response dated September 11, 1999. Accordingly, Applicant invites the current Examiner to review its catalog, submitted with its last response, which shows the goods on which Applicant uses the mark.

**RESPONSE**

**No Likelihood of Confusion under Section 2(d)**

The Examining Attorney has refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), alleging likelihood of confusion with the mark "S/LINK" as shown in U.S. Registration No. 1,962,364.

With helpful input from the Examiner, Applicant has amended its application to specify and limit the field of use for its goods, to delete indefinite terms, and to exclude use of its mark for the goods recited in U.S. Registration No. 1,962,364. In view of the above amendments, it is respectfully requested that the Section 2(d) refusal be withdrawn. Nevertheless, Applicant presents the following additional arguments in response to the Examining Attorney's 2(d) refusal.

The Court of Customs and Patent Appeals, the predecessor to the Court of Appeals for the Federal Circuit has identified thirteen factors to consider in determining questions of likelihood of confusion. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973). Among these factors are (1) the similarity or dissimilarity and nature of the goods or services; and (2) the similarity or dissimilarity of established, likely-to-continue trade channels Id. at 1361. A consideration of these factors confirms that no likelihood of confusion exists between the cited mark and Applicant's mark.

(1) **Dissimilarity of the Goods**

Substantial differences exist between Applicant's goods, as amended, and those of the cited registrant, thereby reducing likelihood of confusion between the marks. Even if

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the marks themselves are somewhat similar, this circumstance alone does not result automatically in a finding of likelihood of confusion. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between EDS for power supplies or battery chargers versus E.D.S. for computer services); *see, also, In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984) (no likelihood of confusion between PLAYERS for shoes and PLAYERS for men's underwear).

Applicant's goods, as amended, are: Electrical communication apparatus, namely input/output connectors for (PLC) programmable logic controllers, controllers for connection to open networks, control boards for actuator sensors, input/output arrayed terminals for actuator sensors, input/output modules, hook-up connectors, photoelectric sensors, proximity sensors, pressure sensors, fiber sensors, ultrasonic sensors; handy monitors with controller functions for use in testing power cables and telecommunications cables; electric, power, telecommunications and optical fiber cables; optical communication apparatus, namely optical modulators, optical isolators, optical switches and optical circulators; excluding computer software for translation, transfer and sharing of data between digital audio and video processing workstations systems.

In contrast, the goods in the cited registration are limited specifically to: "computer software and instruction manuals provided therewith, used to facilitate the translation, transfer and sharing of data between digital audio and video processing workstation systems."

Applicant's goods, as amended, specifically exclude "computer software for translation, transfer and sharing of data between digital audio and video processing workstations systems". In addition, Applicant has limited the field of use for its "programmable logic controllers", "input/output connectors," "control boards" and "input/output arrayed terminals". The resulting description renders Applicant's goods completely different from those of the cited registrant in terms of their function, purpose and use. Relevant consumers and potential customers of the parties' goods, respectively, are completely different. The amended identification of goods now reflects this.

Where the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g., lamps, tubes) related to the photocopying field). The foregoing case illustrates the well-settled principal that goods that may be broadly categorized as relating to "electronics", but are not *per se* related.

The goods at issue are not sufficiently related in purpose or use, and are not marketed in such a way that they would be encountered by the same persons. While it is possible that someone may note the visual similarity among the marks themselves, it is not likely that relevant consumers would be confused by them. The Trademark Act supports refusal of registration only when confusion is likely, not when there is the "mere theoretical possibility" of confusion. *See In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. 367, 368

(T.T.A.B. 1993) (“mere theoretical possibility” of confusion insufficient to prove likelihood of confusion between “E-COM” for computerized parts availability and order services and “ECOM” for magnetic core memory systems for computers). Consumers are accustomed to distinguishing and discriminating between a vast array of electronics goods that are designed for specialized applications, purposes and uses. Differences in the purpose, use and relevant consumers of the parties goods, respectively, weigh against a finding of likelihood of confusion and in favor of registration.

Applicant’s goods are not related to computer software; nor are they used to facilitate the translation, transfer and sharing of data between digital audio and video processing workstation systems, as are those specified in cited Reg. No. 1,962,364. Accordingly, no likelihood of confusion exists within the meaning of the Trademark Act.

(2) Dissimilarity of Established, Likely-To-Continue Trade Channels

The second of the listed du Pont factors in the likelihood of confusion analysis is the circumstances under which the goods to which the marks are applied are sold and purchased. Applicant’s and Registrant’s goods are offered through completely different trade channels to different consumers and, therefore, are not likely to be confused by relevant purchasers.

In re Digirad Corp., 45 U.S.P.Q.2d 1841 (T.T.A.B. 1998) is on point here. In Digirad the applicant conceded a marginal customer overlap since both the applicant’s and the cited registrant’s goods were medical diagnostic equipment and sold to hospitals. Id., at 45 U.S.P.Q.2d 1841. However, the medical diagnostic equipment of each party was marketed to

different consumers, i.e., applicant's goods targeted doctors and technical experts in medical equipment in a hospital setting whereas registrant's goods were routinely procured by purchasing agents, also in hospitals. The applicant's goods were sold directly to customers in meetings and demonstrations; the registrant's goods were sold in catalogs and "off the shelf". Id. The difference in trade channels was considered sufficient to avoid likelihood of confusion.

In the instant case, the trade channels of the parties are far more different than in Digirad, rendering confusion between the marks unlikely. Even if the goods of the parties were characterized as being in the same broad field, such as "electronics", the products involved here are not offered through similar trade channels. To the contrary, they target completely different consumers and users.

More specifically, the goods under Applicant's mark relate to electrical communication apparatuses that transmit electronic signals through input/output devices on 4 common wires (2 power supply, 2 signal) to interface with every manufacturers' programmable logic controller. This connection system reduces the number of electric wires and terminal blocks, reduces the time required for equipment wiring and maintenance and increases space efficiency through the use of a smaller control box. This connection system works with every manufacturers' input devices including: photoelectric, proximity and fiber-optic sensors as well as pushbuttons, selector switches, limit switches and pneumatic valve position sensors, as well as all output devices including: relays, indicating lights, motor starters and pneumatic manifold valves. Applicant's products under the mark S-LINK (& Design) are targeted to electronics specialists and professionals in the field of electronics communications devices and components.

Conversely, registrant's goods are computer software for use in the transfer and sharing of data between digital audio and video processing workstations. Purchasers of registrant's computer software are technicians in the field of audio and video processing, not specialists in electronics devices and components. The goods of the parties are marketed under completely different circumstances and to different consumers. In fact, Applicant's mark does not relate to computer software or to digital audio and video processing workstations of any kind. Accordingly, it is highly unlikely that purchasers would assume that these goods had a common origin.

The different channels of trade and uses for the parties goods weigh in favor of registration and against a likelihood of confusion.

In conclusion, because of differences in the nature, purpose and use of the goods and the separate channels of trade, no likelihood of confusion exists in this case within the meaning of the statute. Applicant respectfully requests that the refusal under Section 2(d) be withdrawn.

It is respectfully submitted that the application is now in condition for publication and early notice of same is earnestly solicited. However, if the Examining Attorney has any questions, she may contact the undersigned at 202 672-5300 in Washington, D.C.

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A Notice of Appeal is being filed concurrently herewith, along with a Request for Suspension of Appeal in order to afford the Examiner sufficient time to consider the arguments presented.

Respectfully submitted,

Date: June 10, 2003

By:



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